

Serial No. 09/785,230
Group Art Unit: 2164
Examiner: Leslie Wong

Docket No.: 1046.1242

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Mamiko KURAMOCHI

Serial No. 09/785,230

Group Art Unit: 2164

Confirmation No. 4371

Filed: February 20, 2001

Examiner: Leslie WONG

For: DATA PROCESSING SYSTEM AND DATA PROCESSING METHOD

REPLY BRIEF UNDER 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed September 25, 2007, Appellant timely submits the present Reply Brief on November 26, 2007 (November 25, 2007 falling on a Sunday). In accordance with 37 CFR §41.41, no new or non-admitted amendments, affidavits, or other evidence is being submitted.

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I. Status of Claims

Claims 1-38 are presently pending. Claims 1, 9, and 16 are the independent claims. Claims 2-8, 10-15, and 17-38 are dependent claims.

Claims 1-38 stand finally rejected by the final Office Action mailed April 11, 2006. The rejection of claims 1-38 are the subject of this appeal.

II. Grounds of Appeal

1. The first ground of rejection to be reviewed is whether the Office has made out a prima facie case of obviousness in its rejection of claims 1-22 and 24-38 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,484,178 to Bence, Jr. et al. in view of U.S. Patent No. 6,594,664 to Estrada et al.

2. The second ground of rejection to be reviewed is whether the combination of U.S. Patent No. 6,484,178 to Bence, Jr. et al. and U.S. Patent No. 6,594,664 to Estrada et al. teach or suggest each and every feature of independent claims 1, 9, and 16.

III. Reply to Examiner's Answer Concerning the First Ground of Appeal

The Applicants respectfully maintain that the Office has not met its burden to establish a prima facie case of obviousness during prosecution.

This first ground of appeal is a direct legal question, "has the Examiner met his burden to establish a prima facie case of obviousness?" The Examiner's response to this question, beginning at page 10 of the Examiner's Answer, is to present for the first time an explanation of how the Office is now applying the secondary citation to Estrada. Specifically, the Examiner's Answer expressly states:

In response, to the preceding arguments [concerning the first ground of rejection], Examiner respectfully submits that Estrada teaches the claimed limitation: "a second operation in which the specifying module firstly selects the format file and secondly drags the selected format file to the data file"

(Examiner's Answer, page 10).

This "response" is at best inapposite because it does not address the merits of this ground of appeal (i.e., the sufficiency of the record). Also, this "response," is itself evidence of the absence of a prima facie case of obviousness in the prosecution record.

Firstly, the Examiner's response is inapposite because it is not directed to the legal question presented by this ground of appeal. Rather than, for example, pointing to any portion of any Office Action to rebut Appellant's position that the Examiner's final rejection ignores the expressly recited feature of "a second operation in which the specifying module firstly selects the format file and secondly drags the selected format file to the data file," the Examiner instead presents a new explanation of how the Office is now applying Estrada. This response avoids the merits of this legal question. And, by avoiding the merits, the Examiner's Answer fails to address, for example, the specific failure articulated at page 10 of the Second Amended Appeal Brief.

Secondly, the Examiner's newly-presented explanation of the Office's application of Estrada is an implicit acknowledgement by the Examiner that he failed to meet his burden to

establish a prima facie case in the prosecution record. Appellant respectfully submits that the Examiner's need to set forth a new explanation of how the Office is now applying Estrada, rather than identifying where in the record a prima facie case was made, highlights the deficiencies of the Office Actions in this application. As such, page 10 of the Examiner's Answer constitutes additional evidence of the Examiner's failure to meet his burden of establishing a prima facie case of obviousness.

Also, it is to be appreciated that the lengthy explanation of the Office's application of Estrada, at page 10 of the Examiner' Answer, is being presented for the first time. In doing so, it is respectfully submitted that the Examiner is now, on appeal, attempting to establish the necessary prima facie he failed to establish during prosecution. This explanation would have been appropriate during prosecution, not on appeal. And, although he has not designated it as such, the Examiner is, in essence, presenting a new ground of rejection because these arguments were not presented during prosecution. The failure to present these arguments during prosecution offends the principals of the Office's policy of compact prosecution because Appellant did not have the opportunity to respond to them. Further, in response to this new ground of rejection, Appellant respectfully requests that prosecution be reopened pursuant to 37 CFR 41.39(b)(1).

VI. Reply to Examiner's Answer Concerning the Second Ground of Appeal

Appellant respectfully maintains that the secondary citation to Estrada cannot reasonably be applied in the manner asserted by the Examiner.

As explained at the bottom of page 12 and page 13 of the Second Amended Appeal Brief, express teachings of Estrada preclude the Office's stated interpretation of that patent. These express teachings would motivate one of ordinary skill not to reverse the functionality of Estrada to meet the claim feature of "a second operation in which the specifying module firstly selects the format file and secondly drags the selected format file to the data file."

In response to this argument, however, the Examiner addresses some type of "teaching away" argument that has not been presented. And, despite a lengthy explanation of relevant law, the Examiner has not responded with a reason as to why one of ordinary skill would have been motivated to modify Estrada despite the specifically identified "de-motivating" teachings.

Lastly, in response to the Examiner's assertions that Appellant is relying on features not in the claims, Appellant stands by both the articulation of the claims in the Second Amended Appeal Brief and the arguments presented therein.

V. Conclusion

Appellant respectfully maintains that the Office has not made a prima facie case of the obviousness of claims 1-38 and that the art cited by the Examiner is insufficient to maintain an obviousness rejection of the rejected claims. Thus, the rejection of claims 1-22 and 24-38 under 35 U.S.C. §103(a) is improper. Reversal of this rejection is therefore proper and respectfully requested.

The Commissioner is hereby authorized to charge any additional fees required in connection with the filing of this Reply Brief to our Deposit Account No. 19-3935.

Respectfully submitted,

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